

## **REMARKS**

The Final Office Action of June 2, 2006, has been considered by the Applicants. Claims 1, 7, 8, 10, and 31-33 have been amended. Claim 2 has been cancelled. Claims 1, 4-8, and 10-34 remain pending in the Application. Reconsideration of the Application is requested.

Claims 10 and 31-33 were rejected under 35 U.S.C. 112, second paragraph as indefinite. Applicants traverse the rejections.

Claim 10 was rejected as failing to further limit the subject matter of claim 1, which recited a chocolate base comprising cacao butter. Applicants have rewritten claim 10 to recite that the chocolate base may further comprise bitter chocolate. Support for this amendment is clear. Applicants submit this amendment overcomes the rejection.

Claims 31-33 were rejected as being confusing in the use of the phrase "further comprising." Upon review, Applicants believe the Examiner meant it was unclear whether claims 31-33 specifically recited the second additive from claim 8 or a third additive. Applicants have amended claims 8 and 31-33 to make clear that claims 31-33 recited the second additive from claim 8. Support for this amendment is clear. Applicants note that MPEP § 608.01(n) states that a multiple dependent claim cannot serve as the basis for another multiple dependent claim. As claims 31-33 are not multiple dependent claims, there should be no objection on this basis.

Based on these amendments, Applicants request withdrawal of the rejections. Applicants take the position that these amendments merely clarify the meaning of these claims; they do not change the scope of the claims.

Claims 1, 8, 24, and 26 were rejected under 35 U.S.C. 102(b) as anticipated by Damour (5,563,144). Applicants traverse the rejection.

Claim 1 has now been amended to recite the subject matter of claim 2. Please note that claim 8 was amended solely to remove claim 2 from its listing and to overcome the indefiniteness rejection. The scope of claim 8 has not changed because of these amendments.

Damour does not disclose a chewable soft capsule. The Examiner cites a section mentioning a composition comprising cacao butter for use as a suppository or a rectal capsule. One might hope a rectal capsule is soft(!), but that property is not taught nor is it inherent in such a capsule. Similarly, a rectal capsule is not inherently chewable. In addition, Damour does not teach aging the capsule. Therefore, Damour does not anticipate the instant claims.

In the Response to Arguments section of the Office Action, the Examiner stated that Applicants argued the chewability of the capsule, which was not a feature recited in the rejected claims. Applicants have now amended claim 1 to recite this feature. Applicants request withdrawal of the 102(b) rejection over Damour.

Claims 1, 2, 4-7, 10-17, and 19-30 were rejected under 35 U.S.C. 103(a) as obvious over Liu (4,576,826) in view of Borkan (4,935,243). Applicants traverse the rejection.

Not all claim limitations are met by the combination of references. MPEP § 2143.03. As noted against the prior 102(b) rejection over Liu, Liu does not teach that the flavorant capsule comprises cacao butter, as required by the instant claims. Therefore, his product is inherently different from the soft capsules of the instant claims. As evidence, note that they are intended merely to deliver aromatic or flavor components. See col. 1, lines 8-17. Also, Liu discusses distillates of tea, coffee, chocolate, etc; see col. 3, lines 13-23. Cacao butter cannot reasonably be considered a distillate, whereas a flavor or aromatic principle may. Borkan is used to teach properties of the shell and does not appear to remedy this deficiency.

In addition, the references teach away from their combination. Borkan teaches, in col. 5, lines 45-48, that the fill material should contain about 5-7% or less water to minimize deterioration of the aqueous shell. Liu teaches a stable emulsion of an edible oil and an aqueous essence, around which the shell is formed, or capsules made without oil, i.e. only aqueous essence; see col. 2, lines 17-44. Liu also teaches the importance of the presence of water in forming his shell (which the Examiner admits does not meet the claim limitations); see col. 3, lines 4-12. Liu states the emulsion may contain 25-80% oil; this implies that it contains 20-75% water; see col. 3, lines 57-66. Borkan teaches away from having a fill material with this amount of water. Therefore, there is no motivation to combine Liu and Borkan. MPEP § 2145(X)(D).

The claims are non-obvious over the combination of Liu and Borkan. Applicants request withdrawal of the rejection.

Claims 1, 2, 4-8, 10-17, and 19-30 were rejected under 35 U.S.C. 103(a) as obvious over Nitardy (2,206,113) in view of Ebert (4,532,126). Applicants traverse the rejection.

The Examiner stated that Nitardy did not expressly teach aging the fill material. Ebert teaches drying the freshly made capsule for a length of time at room temperature, but did not expressly teach drying at 30-40 °C. The Examiner then tried to use Sacripante or Takegawa to show that room temperature encompasses 30-40°C.

Room temperature would never be interpreted by one skilled in the art as encompassing the range of 30-40° C. For example, Webster's II New College Dictionary, ISBN 0-395-96214-5, defines room temperature as "an indoor temperature of 20 to 25 ° C".

One skilled in the art would certainly not look to Sacripante or Takegawa to learn what room temperature is. In order to rely on these references as teaching a definition of room temperature, they must be analogous prior art. To be analogous, they must either be in the field of Applicants' endeavor or be reasonably pertinent to the particular problem with which the invention is concerned. MPEP § 2141.01(a)(I). Sacripante and Takegawa are not analogous. As partial evidence, they are in different classes from the instant application because they deal with different subject matter. Sacripante deals with ink compositions and is listed in class 106. Takegawa deals with fabricating electrodes for discharge lamps and is international class H01J, corresponding roughly to US class 315. This application, on the other hand, is being examined in class 424. Neither reference would logically have commended itself to an artisan's attention in considering what temperature to dry an ingestible capsule either. Therefore, they cannot be considered analogous and should not be relied on as teaching that room temperature encompasses the range of 30-40 °C. It may be obvious in light of Nitardy and Ebert to dry the capsule, but mere use of the term "drying" is not equivalent to maintaining the temperature between 30-40 °C for five hours or more, as required by claim 1. This argument was made in the previous Office Action and was not addressed by the Examiner.

In the Response to Arguments Section of the Office Action, the Examiner was unable to determine the distinction between the step of drying the capsule and the step of aging the fill material. Accordingly, the Examiner stated the teaching of drying the filled capsule in Ebert would be inherent and obvious in the claimed aging step.

Applicants agree that the two steps can be performed separately or together. The difference is that the step of drying the capsule is performed for the purpose of obtaining a dried capsule. It is not performed for the purpose of aging the fill material. The Examiner did not show where Ebert taught drying the capsule at 30-40°C for 5 hours or more, as required by the instant claims.

Applicants also submit that the Examiner's reasoning is incorrect. The Examiner must show that the claimed aging step is inherent and obvious from the teaching of drying the filled capsule in Ebert (not vice versa, as stated by the Examiner). Otherwise, the Examiner is using improper hindsight based on the teachings of this application. MPEP § 2145(X)(A).

Because Nitardy and Ebert do not teach aging at a temperature of 30-40 °C for 5 hours or more, the claims are not obvious over this combination of references. Applicants request withdrawal of the 103(a) rejection.

Claims 31-34 were rejected under 35 U.S.C. 103(a) as obvious over Nitardy, in view of Perry (EP 0904064) and Miyake (4,219,439). Applicants traverse the rejection.

Claims 31-34 depend from independent claim 1. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. MPEP § 2143.03; *In re Fine*. Nitardy does not render claim 1 obvious because, among other things, he does not teach aging the cacao butter to achieve the structural differences therefrom. Neither Perry nor Miyake remedy this deficiency and this combination of references therefore cannot render claims 31-34 obvious. Applicants request withdrawal of the 103(a) rejection.

Claim 18 was rejected under 35 U.S.C. 103(a) as obvious over Nitardy in view of Mehta. Applicants traverse the rejection.

Claim 18 depends from independent claim 1. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. MPEP § 2143.03; *In re Fine*. Nitardy does not render claim 1 obvious because, among other things, he does not teach aging the cacao butter to achieve the structural differences therefrom. Mehta does not remedy this deficiency and this combination of references therefore cannot render claim 18 obvious. Applicants request withdrawal of the 103(a) rejection.

In the Response to Arguments Section of the Office Action, the Examiner stated that Applicants argued that Borkan, Ebert, and Mehta did not achieve their superior taste in the same way as the instant application. The Examiner further stated that this statement was not supported by any Declaration. In response, Applicants note that Borkan, Ebert, and Mehta did not disclose the use of cacao butter. Applicants showed in the specification that the product-by-process capsule of the claims achieved its taste by the formation of crystals, i.e. a structural difference. Applicants merely intended to make the point that the process by which the superior taste is achieved is relevant to a product-by-process claim. Applicants did not intend to state that the superior taste of the references is detrimentally different. Therefore, no declaration is believed to be required.

The Examiner also stated that Applicants argued that Liu did not teach the claimed temperature of 30-40°C. Applicants agree that Liu teaches a temperature range of 0-40 °C. The Examiner appears to have misunderstood Applicants' comments. Applicants wish to make clear that Liu did not use the term "room temperature" in referring to this temperature range. Liu further stated a preference of ambient temperature (around 20 °C). Liu also teaches away from the upper end of her range when she stated that as the temperature rises, the emulsion becomes less stable. Applicants' intent was to show that Liu should not be used to teach "room temperature" as including 30-40 °C.

Applicants again note the significance of the aging temperature range being between 30 and 40 °C. In particular, Applicants wish to point out Figure 2 and its discussion in the specification as Production Example 29 and 30, beginning on page 36 and going to page 37, line 18. This portion of the specification is a study of the aging temperature, wherein fill material is aged for 16 hours at 25°C, 30°C, 35°C, and 40°C. The hardness of the fill material peaked at a temperature of 35°C. The results of cacao butter alone paralleled this curve, which indicates that the hardness of the fill material was due to

the properties of the cacao butter. The cacao butter consisted of mainly V-type crystals, which is the structural difference between this invention and the prior art. Because of the temperature-dependent formation of V-type crystals, aging outside the range of 30-40°C will not obtain the present invention.

In the Advisory Action of March 8, 2007, the Examiner stated that the amendment filed February 19, 2007 deleting cacao butter from the Markush group of claim 10 narrowed the scope of the claims, requiring further search. Applicants note that claim 10 is a dependent claim and cacao butter was deleted in response to the indefiniteness requirement. Cacao butter was already recited in independent claim 1. Thus, the scope of independent claim 1 was not narrowed and a further search should not be required in order to determine the patentability of claim 1. Nonetheless, in the interest of expediting prosecution, Applicants submit this RCE and Preliminary Amendment.

## CONCLUSION

For the reasons given above, it is respectfully submitted all pending claims (1, 4-8, and 10-34) are now in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.


In the event the Examiner considers personal contact advantageous to the disposition of this case, she is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

Respectfully submitted,

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March 26, 2007

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Under 37 C.F.R. § 1.8, I certify that this Amendment is being

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Date
March 26, 2007

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Lynda S. Kalembe

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